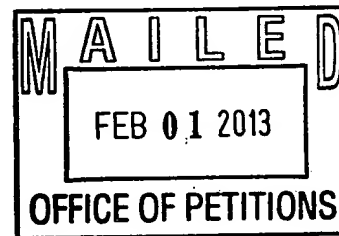




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ROBERT A. LAWAL
2046 SPRINGBANK ROAD,
MLSSISSAUGA, ONTARIO L5H 3N6
CANADA



In re Patent No. 6,367,798
Issue Date: April 9, 2002
Application No. 09/659,839
Filed: September 11, 2000
Title of Invention: **WORD GAME**

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ON PETITION

This is a decision on the petition filed under 37 CFR 1.378(b), January 3, 2013, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

The patent issued on April 9, 2002. The second maintenance fee due could have been paid during the period from April 9, 2009 to October 8, 2009 or, with a surcharge during the period from October 9, 2009 to April 9, 2010. Accordingly, this patent expired on April 9, 2010 for failure to timely remit the maintenance fee.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by:

- (1) The required maintenance fee set forth in § 1.20 (e) through (g);
- (2) The surcharge set forth in § 1.20(i)(1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks item (3) above.

Petitioner asserts failure to be notified that the maintenance fee was due and financial inability to pay the maintenance fee as the unavoidable delay that led to the expiration of the patent.

"I was represented by the firm Ridout & Maybee at that time and I successfully paid the 3 1/2 year payment upon receiving notice from my legal counsel. I have not received correspondence from that firm in a number of years.

I did indeed take reasonable care to ensure that the maintenance fees would be kept current by setting up calendar alerts, but with changes in my telephone and computer systems, the calendar alerts haven't been consistent. As well a number of issues have arisen that have drawn my attention and available funds away from this invention that is so dearly important to me. Among other things, I have suffered the deaths of both of my parents, my congregation was completely without heat in our building for nearly a year because we did not have the funds to pay for the furnace replacement and my own home was flooded due to a sewer back-up. I only receive a very modest monthly stipend from the church and that stipend is only paid when the church has the financial means to pay it. The church has not been financially stable enough to pay that stipend consistently.

My wife contacted the USPTO Patents office in January 2011 and was advised that the patent had lapsed due to the failure to pay the 7 1/2 year maintenance fee. She was advised that the patent could be reinstated as long as I made a full payment of the maintenance fee and applicable surcharges by no later than April 8, 2013. Upon hearing of this absolute deadline, we made diligent efforts to secure the required amounts and after borrowing from a number of sources, we have thankfully been able to put together the requisite fee and surcharge amounts a few months in advance of the deadline. I am asking that the Petitions Office kindly consider my unique circumstances, my small entity status and my sincere desire to maintain this patent that I fought so hard to secure".

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the

¹Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

²Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.⁴ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.⁵

The showing of record is inadequate to establish that the delay in timely paying the maintenance fee was unavoidable within the meaning of 37 CFR 1.378(b)(3).

Petitioner has not provided any evidence to establish who held the responsibility for paying the maintenance fees or that it was therefore unavoidable to that party. If petitioner's attorney/agent was responsible for paying the maintenance fees, they should provide a statement as to why the failure to do so in a timely manner was unavoidable. Petitioner is reminded that in the absence of an adequate showing of the diligence of his representatives in this matter throughout the period in question, the actions or inactions of the registered practitioners will remain imputed to the inventors.⁶

It is incumbent upon the petitioner to demonstrate, via a documented showing, that the entire delay was unavoidable which would include from the time the maintenance fee was due until the time petitioners became aware that the maintenance fee had not been paid, as well as from that point until the filing of the instant petition.

Any showing of unavoidable delay must include a statement from the principals responsible for payment of the maintenance fees as to why action was not taken to timely submit the required maintenance fee while the patent was under their control.

³In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁴Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

⁵Id.

⁶See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

Further, a showing of unavoidable delay based upon financial condition must establish that the financial condition of the patentee during the **entire** period of the delay was such as to excuse the delay.⁷ In order to establish unavoidable delay based on financial difficulty, patentee must provide a showing of the responsible person's financial condition at the time, including income, expenses, assets, credit, and obligations, which made the delay in payment of the fee unavoidable. Patentee must provide copies of any documents or records that would confirm the financial difficulty.

Patentee is cautioned to avoid submitting personal information in documents filed that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, patentee should consider redacting such personal information from the documents before submitting them to the USPTO.

Since patentee has not provided enough information for a determination that reasonable care was in fact exercised to ensure that the maintenance fee would be paid timely and that therein the delay was unavoidable, the argument fails.

As patentee has not provided a showing of evidence to satisfy the requirements of a grantable petition under the unavoidable standard, the petition will be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

/Patricia Faison-Ball/

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

⁷Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).